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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/700,457	11/05/2003	Shuichi Nawae	KAW 106	6390
23995	7590	10/10/2007		
RABIN & Berdo, PC 1101 14TH STREET, NW SUITE 500 WASHINGTON, DC 20005			EXAMINER EL SHAMMAA, MARY A	
			ART UNIT	PAPER NUMBER
			2883	
			MAIL DATE	DELIVERY MODE
			10/10/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/700,457

Applicant(s)

NAWAE ET AL.

Examiner

Mary A. El-Shammaa

Art Unit

2883

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 11-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 4-10 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/03, 6/06, 10/06.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Applicant's election without traverse of Group I in the reply filed on 8/14/2007 is acknowledged. Claims 11-20 are withdrawn.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1 and 4-9 are rejected under 35 U.S.C. 102(e) as being anticipated by Shimada et al. (US 2003/0035634 A1).

Regarding claim 1, Shimada discloses in at least figures 1 and 4, an optical module, comprising: a substrate (12); an optical element (13) that is fixedly secured to said substrate (12); and an optical transmission member (46) that is coupled to said optical element (13) and fixedly secured on said substrate (12), wherein said substrate (12) is made of a substrate having a through hole (not shown in figures, but discussed in at least paragraph [0085]) between a secured portion of said optical element (13) and a secured portion of said optical transmission member (46). (See at least paragraphs [0082], [0085-0089], [0097], [0012], [0016].)

Regarding claim 4, Shimada discloses said substrate is made of AlN or SiC. (See at least paragraph [0085].)

Regarding claim 5, Shimada discloses said optical element (13) is at least one member selected from the group consisting of a light emitting device, a light receiving device, a lens that is coupled to a light emitting device or a light receiving device, a coupled device between a light emitting device or a light receiving device and a lens, and a light-guide path. (See at least paragraphs [0097] and [0112].)

Regarding claim 6, Shimada discloses said optical transmission member (46) is made of an optical transmission path or an optical parts assembled member to be coupled to an optical transmission path. (See at least paragraphs [0082], [0085-0089], [0097], [0012], [0016].)

Regarding claim 7, Shimada discloses said optical parts assembled member is at least one member selected from the group consisting of an assembled member having a collimator lens, an isolator, a light converging lens and a sleeve that are combined into a tube, a combined member of an isolator and a converging lens, and a rod lens. (See at least paragraphs [0082], [0085-0089], [0097], [0012], [0016].)

Regarding claim 8, Shimada discloses said optical transmission member is fixedly secured onto said substrate through an optical transmission member securing base made of glass ceramics, mullite or quartz. (See at least paragraph [0116] and claim 8.)

Regarding claim 9, Shimada discloses said optical element is formed of a semiconductor laser chip, and said optical transmission member is formed of an optical fiber. (See at least paragraphs [0082] and [0089].)

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shimada in view of De Donno et al. (US 2002/0015560 A1).

Regarding claim 10, Shimada does not disclose the optical fiber having a tip-wedge-shaped lens.

De Donno discloses in at least paragraph [0016] a fiber with a tip-wedge-shaped lens.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a tip-wedge-shaped lens as taught by De Donno. The motivation to use said lens is to reduce problems related to centering the beam in the fiber.

***Allowable Subject Matter***

Claims 2 and 3 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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*Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mary A. El-Shammaa whose telephone number is 571.272.2469. The examiner can normally be reached on M-F (8:30am-5:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Frank G. Font can be reached on 571.272.2415. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MAE  
September 29, 2007



Frank G. Font  
Supervisory Patent Examiner  
Technology Center 2800